

Application Serial No. 10/696,532
Reply Brief

Customer No. 01933

Attorney Docket No. 03653/LH

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT
APPEALS AND INTERFERENCES**

Applicant(s): Naobumi OKADA

Serial No. : 10/696,532

Confirm. No.: 6456

Filed : October 28, 2003

For : MICRODISSECTION APPARATUS AND METHOD

Art Unit : 3742

Examiner : Maria Alexandra Elve

Appeal No. :

This paper is being submitted
via EFS-Web on November 26, 2008

In the event that this Paper is
late filed, and the necessary
petition for extension of time
is not filed concurrently
herewith, please consider this
as a Petition for the requisite
extension of time, and to the
extent not already paid,
authorization to charge the
extension fee to Account
No. 06-1378. In addition,
authorization is hereby given to
charge any fees for which
payment has not been submitted,
or to credit any overpayments,
to Account No. 06-1378.

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R :

This is responsive to the Examiner's Answer mailed
October 3, 2008.

This Reply Brief is being timely filed within two months of
the Examiner's Answer, by the due date of December 3, 2008.

R E M A R K S

It is respectfully submitted that, even in view of the Examiner's comments in the Examiner's Answer, the references USP 6,639,657 ("Baer et al") and USP 4,842,782 ("Portney et al") do not render obvious claims 1-36. Indeed, Baer et al and Portney et al are not properly combinable as suggested by the Examiner. And even if considered together, Baer et al and Portney et al do not render obvious the structure and method of the present invention as recited in independent claims 1, 12 and 23.

Baer et al discloses a microdissection apparatus that extracts extremely small cell clusters from a tissue of a living body. Portney et al, on the other hand, discloses a manufacturing technique of ophthalmic lenses such as contact lenses, corneal implants, and intraocular lenses. Thus, Baer et al and Portney et al are clearly from entirely unrelated technical fields, and it is respectfully submitted that one of ordinary skill in the art having common sense would have had no reason, at the time the present invention was made, to turn to Portney et al to improve the apparatus of Baer et al. See, for example, pages 19-20, 35 and 42 of the Appeal Brief.

On page 8 of the Examiner's Answer, the Examiner asserts that the variable aperture of Baer et al corresponds to the active optical element recited in claim 1. The Examiner further asserts on page 8 of the Examiner's Answer that Portney et al

discloses a variable pattern that is set to correspond to a necessary area, as recited in claim 1. The Examiner makes similar assertions with respect to claims 12 and 23 on pages 21-22 and 25 of the Examiner's Answer.

Claim 1 recites "an active optical element on which a variable pattern set to correspond to a necessary area is formed" (for example, a transmission type liquid crystal substrate or a micro mirror array as recited in claims 34 and 35). Claim 12 recites "pattern forming means for transmitting or reflecting the laser light selectively in accordance with a variable pattern which is set to correspond to a necessary area."¹ And claim 23 recites "forming a variable pattern on an active optical element such that the pattern is set to correspond to a necessary area of a sample."

¹The recitation of the "pattern forming means" in claim 12 is a means-plus-function recitation in accordance with 35 USC 112, sixth paragraph. See page 33 of the Appeal Brief.

The structure in the specification corresponding to the pattern forming means recited in claim 12 is the transmission type active optical element 12, which is a liquid crystal substrate, for example (page 8, lines 9-13), or the reflective type active optical element 25, which is a micro mirror array, for example (page 22, lines 18-23). See pages 32-33 of the Appeal Brief.

The Examiner may not disregard the structure disclosed in the specification corresponding to the "pattern forming means" when rejecting claim 12. (See, for example, the discussion in MPEP 2181.) See page 33 of the Appeal Brief.

Baer et al and Portney et al do not disclose any structure corresponding to the pattern forming means of claim 12. See pages 32-35 of the Appeal Brief.

Thus, according to claims 1, 12 and 23, the active optical element or pattern forming means can freely form a beam irradiation range in accordance with the shape of the specimen.

It is respectfully submitted that it would be impossible to freely form an irradiation range in accordance with the shape of the specimen just with a variable aperture (as disclosed by Baer et al), which can change only the beam diameter. Moreover, the "variable pattern" pointed to by the Examiner in Portney et al is merely achieved by replacing a mask having one shape with another mask having a different shape, where the pattern of each mask is not variable. In the present invention, the user is able use the active optical element or pattern forming means to form suitable irradiation ranges for specimens that have unpredictable shapes. By contrast, Portney et al discloses a structure in which masks with predetermined shapes are used to manufacture a lens.

Thus, neither Baer et al nor Portney et al discloses an active optical element or pattern forming means as recited in claims 1, 12 and 23.

In summary, it is respectfully submitted that it is illogical to combine the disclosure of the variable aperture of Baer et al with the disclosure of the fixed masks of Portney et al to achieve an active optical element or pattern forming means as recited in claims 1, 12 and 23. And it is respectfully submitted that Baer et al and Portney et al are not otherwise

combinable to achieve or render obvious an active optical element or pattern forming means as recited in claims 1, 12 and 23.

* * * * *

In view of the foregoing and the Appeal Brief filed on July 14, 2008, it is respectfully requested that this Board reverse the rejection of appealed claims 1-36.

Respectfully submitted,

/Douglas Holtz/

Douglas Holtz
Reg. No. 33,902

Frishauf, Holtz, Goodman & Chick, P.C.
220 Fifth Avenue - 16th Floor
New York, New York 10001-7708
Tel. No. (212) 319-4900
Fax No. (212) 319-5101

DH:iv